

REMARKS

Claims 1 to 29 are pending in the present application.
Claims 1, 19, 22 to 24, and 28 are independent.

Section 103 Rejections

Claims 1 to 12, 19 to 22, and 24 to 27 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over a printout of a website at URLs <http://www.tetrisattack.net/intro.html> (one page) and <http://www.tetrisattack.net/howtoplay.html> (three pages) both dated August 25, 2003 (hereinafter referred to as "Tetris Attack"). Claims 13 to 15, and 23 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Tetris Attack in view of "Archive.org, Uproar.com from December 2000, <http://web.archive.org/web/2000101906614/m-finde.asp>" and/or "Uproar: Net Entertainment, May 1999" (hereinafter both referred to as "Uproar"). Claims 16 to 18, 28, and 29 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over Tetris Attack in view of "Archive.org, MSN Games from October 2000, <http://web.archive.org/web/20001019004922/http://games.msn.com/>" (hereinafter referred to as "MSN Games"). Applicants respectfully traverse the Examiner's Section 103(a) rejections.

Claims 1 to 12, 19 to 22, and 24 to 27 stand rejected based on the Tetris Attack reference alone, however, it is not at all clear to Applicants that the reference represents prior art. The actual document provided is dated August 25, 2003. The Examiner provides no explanation, but Applicants assume this is the date the reference was printed. Clarification is requested. In the second paragraph of the introduction, three different but apparently related games are discussed. Only one of the is actually called "Tetris Attack" and the different games each have different release dates (over a five year period) and locations (in Japan and in the US). The author states that because there are three versions, he or she will refer to "the game" as Tetris Attack. Thus it is not clear which game/version is described in the remainder of the document, when it was released, or where it was released. The document appears to Applicants to describe a game that the author believes was released in 2000 in an undisclosed place. Applicants respectfully request clarification. Absent further clarification, Applicants are unable to assess whether their invention pre-dates the reference or even if the reference is prior art. The Examiner is respectfully reminded that it is her burden to provide a prior art reference and absent such a reference, a *prima facie* case has not been established. Thus, absent clarification, Applicants respectfully request withdrawal of all the Section 103 rejections based on Tetris Attack.

Further, the game described in the Tetris Attack reference does not disclose features of Applicants' claims. Specifically, the following features (or the like), as recited in Claims 1 to 23, are not taught or even suggested:

- each game move comprising . . . removing at least one game icon from the game board based on the player input
- reconfiguring the game board according to one of a plurality of reconfiguration rules
- wherein a reconfiguration rule to be applied during a game move is not indicated to the player during at least a portion of the game play.

First, the Examiner, herself, makes it clear in the Office Action that in Tetris Attack a game icon is only removed “if at least three icons are lined up in [a] . . . predetermined manner.” In contrast, in Applicants’ game as claimed, a game piece is removed each time the player makes a game move. This is a fundamental difference between Tetris Attack and Applicants’ game. In Tetris Attack, game pieces are only removed by arranging pieces in a particular pattern. The player cannot directly remove pieces, only rearrange pieces. In Applicants’ game, game icons may be removed by merely selecting them. Thus, based on this distinction alone, Applicants request withdrawal of the Section 103 rejections of Claims 1 to 23.

Second, Tetris Attack does not reconfigure the game board according to one of a plurality of reconfiguration rules. The Examiner appears to ignore Applicants’ claim language which clearly recites reconfiguring “according to one of a plurality of reconfiguration rules.” Even if Tetris Attack’s basic functions of dropping game pieces when pieces below are cleared and causing pieces to rise from the bottom of the game board could be considered “a plurality of reconfiguration rules,” clearly the board is “reconfigured” according to both “rules” at all times. Alternatively, if either dropping pieces or raising pieces are not both considered “reconfiguration rules,” Applicants note that Tetris Attack lacks a plurality of rules. Thus, based on these distinctions alone, Applicants further request withdrawal of the Section 103 rejections of Claims 1 to 23.

Third, despite the Examiner’s assertion otherwise, the “reconfiguration rules” of Tetris Attack are always known or indicated to a player. Unlike Applicants’ game, players of Tetris Attack always know that game pieces will drop down when pieces below are cleared and they always know that pieces rise from the bottom of the game board. As recited in Applicants’ claims, the “reconfiguration rule to be applied during a game move is not indicated to the player during at least a portion of the game play” in Applicants’ game. The Examiner seems to imply that because the Tetris Attack rules are understood and not repeatedly displayed on the game screen, they are not “indicated” to the player during the game. Applicants disagree. The Tetris Attack game instructions clearly indicate the rules to the player before, during, and after the game. Further, the Examiner explicitly concedes this point on page three of the Office Action in her remarks regarding Claim 2. Thus, based on this distinction alone, Applicants further request withdrawal of the Section 103 rejections of Claims 1 to 23.

Regarding Claim 24 and its dependent claims, although the first feature described above is not recited, the second and third features are recited. Thus, based on these two distinctions, Applicants request withdrawal of the Section 103 rejections of Claims 24 to 27.

Regarding Claim 28 and 29, the Examiner makes the following incorrect assertion:

when a player device has performed an action requiring a reconfiguration rule, Tetris Attack receives an indication from the game controller of a first rule to be applied during the game without receiving an indication of the second game rule to be applied. Indication of the second rule is received only upon the criteria being met for the second rule to be applied (Tetris Attack, How to play from tetrisattack.com and Tetris Attack Manual).

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Despite the above assertion, there is no disclosure in either reference that describes Tetris Attack receiving “an indication from the game controller,” much less an indication that “a first rule [is]

to be applied during the game without receiving an indication of the second game rule [is] to be applied.” Applicants respectfully request that the Examiner identify a passage in either reference that teaches these features. Further, Applicants do not understand what the Examiner means by “an action requiring a reconfiguration rule.” Applicants’ term “reconfiguration rule,” as used throughout Applicants specification, does not refer to anything that is required by any action, much less an action performed by a player device. Applicants respectfully request clarification. The Examiner is reminded that the rules of Tetris Attack are static and are merely applied as the game progresses. There is no switching of reconfiguration rules as in Applicants’ game. Thus, the references do not teach that for which the Examiner relies upon them and therefore Applicants respectfully request withdrawal of the Section 103 rejections of Claims 28 and 29.

Due to the absence of at least the above claimed features in the relied upon references, the Examiner has not met her burden in that she has not established a *prima facie* case of obviousness. Further, the Examiner has not provided any reference or reasoning that would suggest any kind of motivation to modify the game described in the Tetris Attack reference to include the missing claimed features.

Further, in rejecting many of the dependent claims, the Examiner improperly relies upon her own factual assertions, that she characterizes as obvious, known, and/or notoriously well known, as the primary basis for claiming particular features of Applicants’ claims are obvious. Applicants do not accept the Examiner’s characterizations, nor her factual assertions and respectfully request a reference in support of these assertions. Absent such support, Applicants respectfully request withdrawal of the Section 103 rejections for this additional reason.

Beyond not demonstrating that all features of Applicants’ claims are taught by the numerous relied upon references, Applicants assert that the Examiner has not met her burden of establishing a *prima facie* case of obviousness for the additional reason that she has not provided a proper motivation to combine the references. The Examiner has improperly relied upon prohibited hindsight reasoning in providing her own motivation to combine the teachings of Tetris Attack, Uproar, and MSN Games. The Examiner seemingly ignores the problems described in Applicants’ specification regarding providing prizes for winning a game of skill, such as Tetris Attack, in an online embodiment. Applicants assert that a game such as Tetris Attack could not be implemented in an online environment with prizes without substantial modification to the fundamentals of the game and not without undue experimentation. As described in Applicants’ specification, a game with static rules such as Tetris Attack could easily be regularly won using an automated game playing device. Clearly there is no suggestion in Tetris Attack, Uproar, and/or MSN Games to reconfigure the game board of a skill game like Tetris Attack based on one of a plurality of reconfiguration rules without indicating the rule change to the player until the rule is applied. Thus, for this additional reason, Applicants assert that the Examiner’s Section 103 rejections are untenable and respectfully request withdrawal of the Section 103 rejections.

Conclusion

For the foregoing reasons it is submitted that all of the claims are in condition for allowance and the Examiner’s early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of

the present application, the Examiner is cordially requested to contact Applicants' representative, Steven Santisi, at telephone number 203-461-7054 or via electronic mail at santisi@walkerdigital.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Steven Santisi', is written over a horizontal line.

12/31/2003
Date

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